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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,642	02/21/2002	Norbert Hofgen	HUBR-1203.2Cont	4195

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EXAMINER

FAN, JANE T

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,642

Applicant(s)

HOFGEN ET AL.

Examiner

Jane T. Fan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/300,973.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

- 21-27
1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, 19-20 (all in part), drawn to indole-pyridyl derivatives wherein R5 is pyridyl and no other heterocyclic ring of any kind in other variables, classified in classes 514, 546, subclasses various. If this group is elected, an election of a single disclosed species is required. Method of making claims 5-9 and method of using claims 10-18 may be prosecuted together with the elected compounds to the extend of election upon election of a single disclosed process of making and a single disclosed method of use relevant to the elected compounds.
 - II. Claims 1-4, 19-20 (all in part), drawn to phenyl-indoles wherein R5 is phenyl and no other heterocyclic ring of any kind in other variables, classified in classes 514, 548, subclasses various. If this group is elected, an election of a single disclosed species is required. Method of making claims 5-9 and method of using claims 10-18 may be prosecuted together with the elected compounds to the extend of election upon election of a single disclosed process of making and a single disclosed method of use relevant to the elected compounds.
 - III. Claims 1-3, 19-20 (all in part), drawn to the remaining compounds, classified in classes 514, 546, subclasses various. If this group is elected, an election of a single disclosed species is required. Method of making claims 5-9 and method of using claims 10-18 may be prosecuted together with the elected compounds to the

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extend of election upon election of a single disclosed process of making and a single disclosed method of use relevant to the elected compounds.

The inventions are distinct, each from the other because of the following reasons:

The compounds of the groups above are independent and distinct since they differ greatly in chemical structure. The above groups would not be classified together under a scientific mode of classification. The compounds of group I would not be a reference under 35 USC 103 against the compounds of group II. Further note that the heterocyclic moieties cannot be considered as conventional substituents, but rather form a new core of the molecule each time that they are present. Since no common core is present, the inventions are misjoined.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane T. Fan whose telephone number is 703-308-4705. The examiner can normally be reached on 7:00am-3:30pm, Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4734 for regular communications and 703-308-4734 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Jane T. Fan
Primary Examiner
Art Unit 1625

May 9, 2002


JANE FAN
PRIMARY EXAMINER
GROUP 1200